

REMARKS

In response to the Office Action dated 21 January 2004, Applicants request reconsideration and withdrawal of the rejections set forth in the Office Action in view of the above amendments and the following remarks.

The applicants have submitted a new signed oath and declaration as requested. Applicants have also amended the specification and drawings in accordance with the Examiner's request. With regard to the drawings, reference numeral 7 has been added to Figure 1, as is shown on the Replacement Sheet attached.

Claims 1-6 were rejected under 35 U.S.C. §103 (a) as being "unpatentable over Israel (U.S. Patent No. 6139145) in view of Zhang et al. (U.S. Patent No. 5997140.)" To properly maintain a rejection under 35 U.S.C. §103, the prior art must have suggested to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process, with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be adequately founded in the prior art and not in the applicant's disclosure. See *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Moreover, "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention..." M.P.E.P. §2141.

Israel is unacceptable as a primary reference because it does not teach or suggest an ophthalmic lens that comprises a holographic optical element that allows a wearer to switch between multiple optical powers. Israel is directed to "a method of correcting vision defects associated with central field loss." '145 Abstract. The claimed invention relates to "an ophthalmic lens that comprises a holographic optical element that allows a wearer to switch between multiple optical powers" and a "method for making a multifocal lens" US Application No. 10/025,951, page 1, lines 2-5. Applicants have amended claim 1 to include the limitation that the optical lens be a multifocal lens.

Additionally, Israel teaches away from focus on the fovea and multifocal lenses:

Although both images are formed on the fovea, the brightness of the image in each case is reduced by about 50%, or the ratio of the light intensity assigned to each image. In certain cases, such a lens can be used to treat macular degeneration by providing sufficient image magnification so as to project the image over a retinal area more than

that damaged by macular degeneration. Such an approach, however, does not shift the image to healthy portions of the retina.

Similar multifocal intraocular lenses incorporating two refractive zones also have been disclosed. For example, the use of a pair of bifocal intraocular lenses has been disclosed in which each of the pair of bifocal intraocular lenses incorporates a refractive element and a diffractive element. One of the lenses provides greater image intensity for the image of near objects, while the other lens provides greater image intensity for the image of distant objects. This approach has the advantage that the incident light can be apportioned or split between the two images in a continuous manner between the two lenses. The disadvantage is that the image is processed by two optical elements, each of which introduces its own aberrations and loss of image contrast so that the performance of the compound lens can be worse than either a diffractive or refractive lens.


'125 patent, column 1 line 56- col. 2, line 12.

The invention described in Israel seeks to shift images to healthy portions of the macula, other than the fovea. The present invention, however, operates in a different manner. As disclosed on page 3 of the present application, the present invention includes a "multifocal optical lens that allows a user to actively select between at least 2 focusing powers, yet does not require multiple layers of holograms." *Id.*, lines 20-21. ... "[T]he lens of the present invention uses only one optical power at a time to form a clearly perceivable image along the wearer's line of sight, more specifically at the fovea." *Id.* at page 12, lines 18-21 (emphasis added).

As such, Israel is unacceptable as a primary reference because it does not teach or suggest an ophthalmic lens that comprises a holographic optical element that allows a wearer to switch between multiple optical powers. Applicants respectfully submit that with the above amendment for claim 1, the 103(a) rejection has been overcome and claims 1-3 are in condition for allowance. Applicants respectfully request reconsideration.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Karen Borrelli, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,



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